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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/977,203	10/16/2001	Marc Charbonneau	12-67 US	3581

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EXAMINER

PARTHASARATHY, PRAMILA

ART UNIT	PAPER NUMBER
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2136

MAIL DATE	DELIVERY MODE
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08/15/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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Office Action Summary	Application No. 09/977,203	Applicant(s) CHARBONNEAU, MARC	
	Examiner Pramila Parthasarathy	Art Unit 2136	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22, 24-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.
2. Applicant's submission filed on May 07, 2007 has been entered and made of record.

Response to Remarks/Arguments

3. Amendment to specification has been accepted and entered.
4. Applicant has introduced new objections and rejections to the now amended and new Claims. Please amend the claims as suggested accordingly.

As per amended claims limitations, Applicant argues that cited prior art Langford et al. (Patent 6,470,450) does not teach "system memory locations indicative of executable programs in operation". Examiner directs to Langford Column 4 lines 1 – 14 wherein Langford discloses that the application registration data (second data) generates corresponding unique application verification data ... including location such as data representing a path where the executable file data is located in memory, such as RAM or ROM... system uses the data representing the path to obtain executable file data representing the path to obtain executable file data to compute a hash value of executable file data associated with the calling application. Examiner maintains prior art

Art Unit: 2136

rejection (however, cites other parts of the prior art to disclose newly introduced amended limitations and claims).

Dependent claims are also rejected at least by virtue of their dependency on independent claims and by other reason set forth in this office action. Accordingly, the rejection for the pending Claims 1 – 22 and 24 – 61 is respectfully maintained.

Examiner suggests amending the claims with the already disclosed subject matter in paragraph [0045], to include ... the secure user-authorization system prompts the user to provide user authorization information. ... compares the user provided (fingerprint image) ... refuses the password request and terminates.

Claim Objections

A series of singular dependent claims is permissible in which a dependent claim refers to a preceding claim which, in turn, refers to another preceding claim.

A claim which depends from a dependent claim should not be separated by any claim which does not also depend from said dependent claim. It should be kept in mind that a dependent claim may refer to any preceding independent claim. In general, applicant's sequence will not be changed. See MPEP § 608.01(n).

5. Claim 6 depends upon Claim 8 which depends on Claim 7. However, Claim depends on Claim 6. Examiner does not understand how the dependencies are arranged (with circular dependencies). Claims 6 – 16 are not considered for prior art rejection. Examiner suggests amending these and other dependent claims for proper dependencies.

Art Unit: 2136

Claim 53 is objected to because of the following informalities: Claim ends with a “:”, replace with “.” (**emphasis added**). Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. Claims 2 – 5, 9, 16, 47, 48 and 55 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The amended independent Claims 2 – 5, 9, 16 and 55 recite, “ ... security data” and Claim 47 and 48 recite “within a selected limit” the specification does not disclose “security data” and “within a selected limit”.

Applicant amendment does not clarify and direct wherein the specification such support is disclosed for “security data” and “within a selected limit”.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 22, 25, 47 and 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Art Unit: 2136

Claim 22 recites the limitation "the predetermined data" in line 2. There is insufficient antecedent basis for this limitation in the claim.

The term "within a selected limit" in claims 25, 47 and 48 is a relative term which renders the claim indefinite. The term "limit" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably appraised of the scope of the invention.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Amended Claims 1 – 22 and 24 – 61 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 14 of U.S. Patent No. 5,995,630. Although the conflicting claims are not identical, they are not

Art Unit: 2136

patentably distinct from each other because the instant case, all elements of claims 1 – 22 and 24 – 61 correspond to the claims of 1 – 14 of the patent claims, except in the instant claims the elements “biometric information” and “biometric template”, are referred in the patent claims as “fingerprint” and “image of the fingerprint”.

Claims of the instant application are anticipated by patent claims in that the patent claims contains all the limitations of the instant application. Claims of the instant application therefore is not patentably distinct from the earlier patent claims and as such are unpatentable for obvious-type double patenting (*In re Goodman (CAFC)* 29 USPQ2d 2010 (12/3/1993).

Claim Rejections - 35 USC § 102

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

9. Claims 1 – 5, 17 – 22 and 24 – 61 are rejected under 35 U.S.C. 102(e) as being anticipated by Langford et al. (U.S. Patent 6,470,450).

10. As per Claims 1 and 61, Langford teaches “hashing first data stored in data storage within the computer system using a selected hashing process to determine a computed hash value, wherein the first data includes data representing a current state of at least one application executing within the computer system”;

“retrieving a trusted hash value, wherein the trusted hash value was created using the selected hashing process applied to second data representing a known state of the one or more applications executing in the computer system, wherein the second

Art Unit: 2136

data includes data from at least a system memory location indicative of the at least one application executing within the computer system"; and

"comparing the computed hash value with the trusted hash value to determine whether there is unauthorized executable code in the computer system" (See Langford Column 3 line 36 – Column 9 line 14).

11. As per Claim 17, Langford teaches "providing a trusted security application executable on a processor of the computer system for determining a hash value using a selected hashing process applied to predetermined data existing in memory within the computer system, wherein the predetermined data includes system memory locations indicative of executable program in operation";

"hashing the selected data existing in memory within the computer system using the predetermined process to determine a hash value";

"digitally signing the hash value to provide a trusted hash value; and retrievable storing the trusted hash value, wherein the predetermined data relates to programs in execution on the processor of the computer system when the computer system is in a secure state" (See Langford Column 3 line 36 – Column 9 line 14).

12. Amended Dependent claims are also rejected at least by virtue of their dependency on independent claims and by other reason set forth in this office action. Examiner requests amending dependent claims to overcome claim objections and rejections.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant.

Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO Form 892.

Applicant is urged to consider the references. However, the references should be evaluated by what they suggest to one versed in the art, rather than by their specific disclosure. If applicants are aware of any better prior art than those are cited, they are required to bring the prior art to the attention of the examiner.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pramila Parthasarathy whose telephone number is 571-272-3866. The examiner can normally be reached on 8:00a.m. To 5:00p.m.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nasser Moazzami can be reached on 571-232-4195. Any inquiry of a general nature or

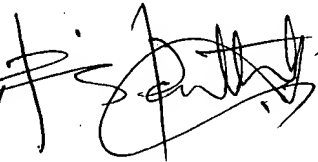
Art Unit: 2136

relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR only. For more information about the PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Pramila Parthasarathy

August 11, 2007.

A handwritten signature in black ink, appearing to be 'P. Parthasarathy', written over the printed name.